

**Serial No. 09/838,491**

**Remarks**

Applicant submits herewith a Supplemental Information Disclosure Statement (IDS) by Applicant (1 page), listing additional references which are or may be material to the examination of the subject application. Copies of the additional references, along with the required fee \$180, are enclosed. It is respectfully requested that they be made of record in the file history of the application.

Identification of references in the IDS is not to be construed as an admission by applicant or attorneys for applicant that such references are available as "prior art" against the subject application. The right is reserved to antedate any listed reference in accordance with standard procedures.

In addition, applicant brings to the Examiner's attention Civil Action No. '04 CV 00614 DMS, which was brought by American Calcar Inc. against BMW of North America, LLC. before the United States District Court for the Southern District of California. This civil action is based on, among others, U.S. Patent No. 6,275,231 ("the '231 patent") issued on Application Serial No. 08/904,855 of which the present application is a continuation. A copy of the cover page of the Complaint is enclosed for the PTO's records and file history of the present application. The name of the inventor of the '231 patent is Michael L. Obradovich. American Calcar Inc. is a Delaware corporation with its principal place of business at 1001 Avenida Pico C139, San Clemente, California. BMW of North America, LLC is a New Jersey limited liability company with its principal place of business at 300 Chestnut Ridge Road, Woodcliff Lake, New Jersey.

The Examiner rejected claims 21-58 under 35 U.S.C. 103(a) as being allegedly obvious over U.S. Patent No. 6,696,927 issued to Flick (hereinafter "the Flick '927 patent") in view of U.S. Patent No. 4,638,295 issued to Middlebrook et al. This rejection is respectfully traversed.

The present application is a continuation of Application No. 08/904,855 filed on

August 1, 1997. Thus, the effective filing date of the present application is August 1, 1997.

Applicant wishes to put on record that the Flick '927 patent may not be prior art because it was filed on October 4, 2002 (after the effective filing date of the present application), although it is a continuation-in-part of earlier Application No. 08/701,356, filed on August 22, 1996, now U.S. Patent No. 5,719,551 (hereinafter "the Flick '551 patent"). Applicant traverses the Examiner's rejection, which is based on the Flick '927 patent, with the assumption that the disclosure in the Flick '927 patent upon which the Examiner relied to reject the claimed invention also appears in the Flick '551 patent. Otherwise if that is not the case, applicant respectfully requests that the Examiner's rejection be withdrawn because the Flick '927 patent is not prior art.

The invention is directed to a technique for providing, in a vehicle, information from information sources outside the vehicle, e.g., entertainment programs broadcast from radio stations. Illustratively, the radio stations are represented by their respective icons and frequencies on a display in the vehicle. The user may select one of the icons representing the station to which he/she wants to listen. However, the geographic coverage of a radio station may be limited. As the vehicle travels beyond the coverage, the broadcast from the station may become too weak to receive. In accordance with the invention, radio stations are grouped according to geographic areas. The radio stations in each group provide relatively good reception in the geographic area associated with the group. In implementation, representations of the radio stations are stored in a memory of the inventive system according to the geographic areas associated with the radio stations. These geographic areas may be identified by their global positioning system (GPS) coordinates. In operation, the inventive system presents a group of representations of radio stations on a display for selection which are associated with the geographic area which the vehicle is in. The inventive system determines whether the current location of the vehicle is within a predetermined range of a second geographic area. If it is, a second

group of representations of radio stations associated with the second geographic area are retrieved from the memory and presented on the display for selection, instead. *See* page 42, line 10 et seq. of the specification, Fig. 18.

The Flick '927 patent discloses a vehicle security system. Applicant carefully reviewed the Flick '927 patent and, in particular, its disclosure at col. 3, lines 8-65 cited by the Examiner. The Flick '927 patent at best discloses use of an alarm controller to operate alarm indicators, e.g., a siren, responsive to a vehicle security sensor. Despite the Examiner's assertion, nowhere does the Flick '927 patent teach or suggest "providing a set of indicators for indicating a group of information sources outside the vehicle," as claims 21 and 41 recite. Applicant cannot fathom from reading the Flick '927 patent what group of information sources outside the vehicle are indicated by alarm indicators in the Flick '927 patent, where the group of information sources is "associated with a location," as claims 21 and 41 further recite. Nor did the Examiner bother to explain what he regards as such information sources in the Office Action. Moreover, nowhere does the Flick '927 patent teach or suggest "each indicator being selectable to receive signals from the information source indicated by the indicator," as claims 21 and 41 also recite.

Middlebrook discloses a vehicle system for generating turn signals indicating whether a driver is committed to a turn. After carefully reviewing Middlebrook and, in particular, its disclosure at col. 4, lines 13-58 cited by the Examiner, applicant is at a loss as to why a person skilled in the art would have combined a vehicle security system for preventing theft in the Flick '927 patent with a turn signal system for improving safety in making a turn in the Middlebrook patent, as postulated by the Examiner. In any event, even if such a combination of references, and the postulation that alarm indicators are analogous to turn signal indicators are valid, nowhere does Middlebrook teach or suggest "determining whether the vehicle is within a predetermined distance from a second location," and that "a second set of indicators indicating a second group of information

sources, which is associated with the second location, [be] provided when it is determined that the vehicle is within the predetermined distance from the second location,” as claims 21 and 41 also recite.

Applicant takes issue with the Examiner’s silence on how he read the claim limitations on the cited references, thereby improperly shifting the burden of examination of the application to applicant. All the Examiner did in the Office Action was copy the representative claim language and allege that it was disclosed somewhere in the Flick ‘927 and Middlebrook patents, which disclosure is remotely relevant to the claimed invention.

For the reasons stated above, claims 21 and 41, together with their dependent claims, are patentable over the cited references. In addition, claim 22 is patentable in its own right as nowhere does the Flick ‘927 patent teach or suggest that “at least one of the information sources includes a radio station,” despite the Examiner’s citation of col. 1, lines 58-67.

Similarly, claims 23 is patentable in its own right as nowhere does the Flick ‘927 patent teach or suggest that “at least one of the information sources includes a television station,” despite the Examiner’s citation of col. 4, lines 14-46. In addition, claims 24-26 are patentable in their own right as nowhere does the Flick ‘927 patent teach or suggest that “at least one of the indicators when selected is highlighted on the display,” despite the Examiner’s citation of col. 6, lines 9-47. Further, claim 27 is patentable in its own right as nowhere does the Middlebrook patent teach or suggest determining “whether the vehicle is within the predetermined distance from the second location by comparing a global positioning system (GPS) measurement identifying a current location of the vehicle with a second GPS measurement identifying the second location,” despite the Examiner’s citation of col. 4, lines 14-67. Moreover, claims 28 and 29 are patentable in their own right as nowhere does the Flick ‘927 patent teach or suggest that “at least one of the indicators includes an icon,” and “the at least one indicator is selectable by pointing

**Serial No. 09/838,491**

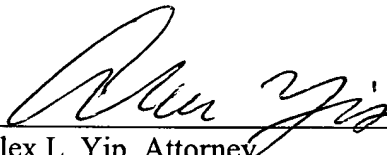
and clicking at the icon,” despite the Examiner’s citation of col. 3, lines 6-42.

Claims 30 and 49 include limitations similar to those of claims 21 and 41 discussed above. For similar reasons, claims 30-49, together with their dependent claims, are patentable over the Flick ‘927 patent in view of the Middlebrook patent.

In view of the foregoing, each of claims 21-58 is believed to be in condition for allowance. Accordingly, consideration of these claims is requested and allowance of the application is earnestly solicited.

Respectfully,

Michael L. Obradovich

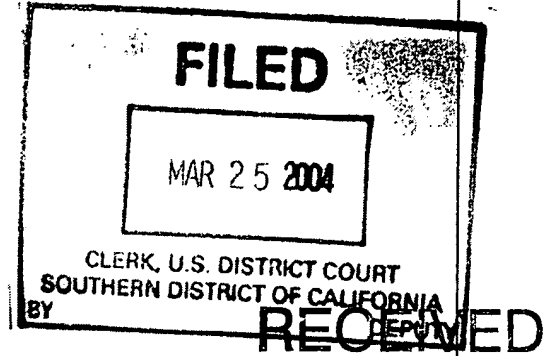
By   
Alex L. Yip, Attorney  
Reg. No. 34,759  
212-836-7363

Date: July 21, 2004

COPY

Frederick S. Berretta (State Bar No. 144,757)  
David K. Wiggins (State Bar No. 222,856)  
John G. Rickenbrode (State Bar No. 228,459)  
KNOBBE, MARTENS, OLSON & BEAR, LLP  
550 West C St.  
Suite 1200  
San Diego, CA 92101  
(619) 235-8550  
(619) 235-0176 (FAX)

Attorneys for Plaintiff  
AMERICAN CALCAR, INC.



JUL 27 2004

Technology Center 2100

IN THE UNITED STATES DISTRICT COURT  
FOR THE SOUTHERN DISTRICT OF CALIFORNIA

AMERICAN CALCAR INC.,  
a Delaware corporation,

Plaintiff,

v.

BMW OF NORTH AMERICA, LLC,  
a New Jersey limited liability company,

Defendant.

Civil Action No.

'04 CV 00614 DMS (LSP)

COMPLAINT FOR INFRINGEMENT  
OF U.S. PATENT NOS. 6,009,355;

6,148,261; 6,275,231; 6,282,464;

6,330,497; 6,438,465; 6,459,961;

6,529,824; 6,542,795; 6,587,758;

6,587,759; 6,703,944

DEMAND FOR JURY TRIAL

Plaintiff AMERICAN CALCAR INC. hereby complains of Defendant BMW OF  
NORTH AMERICA, LLC, and alleges as follows:

JURISDICTION AND VENUE

1. This action for patent infringement arises under the patent laws of the United  
States, Title 35, United States Code, more particularly, 35 U.S.C. §§ 271 and 281.

2. This Court has subject matter jurisdiction under 28 U.S.C. §§ 1331 and 1338(a).

3. Venue is proper in this judicial district under 28 U.S.C. §§ 1391(c) and 1400(b).

///

///

///